

REMARKS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1, 3, 4, 6-11, 13, 14, 16-21, 23, 24, and 26-33 are currently pending. Claims 31-33 have been added by the present amendment. The additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 3, 6-8, 11, 13, 16-18, 21, 23, and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,216 to Motoyama (hereinafter “the ‘216 patent”) in view of U.S. Patent No. 5,963,911 to Walker et al. (hereinafter “the ‘911 patent”); Claims 4, 14, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘216 and ‘911 patents, further in view of U.S. Patent No. 5,864,783 to Struck et al. (hereinafter “the ‘783 patent”); and Claims 9, 10, 19, 20, 29, and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over the ‘216 and ‘911 patents, further in view of U.S. Patent No. 6,167,358 to Othmer et al. (hereinafter “the ‘358 patent”).

Applicants wish to thank the Examiner for the interview granted Applicants’ representative on July 13, 2004, at which time arguments in support of patentability were presented. However, no agreement was reached pending the Examiner’s further consideration of the claims upon formal submission of a response to the outstanding Office Action.

Claim 1 is directed to a system for tracking at least one of a device state and a device event of a remotely located device, comprising: (1) a receiver configured to receive the at least one of the device state and the device event of the remotely located device; (2) a digital storage system configured to maintain a history of the at least one of a device state and device event of the remotely located device, and a service history of the remotely located device; (3)

an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely located device to determine a service request to be performed on the remotely located device; and (4) a service depot comprising a computer configured to receive the service request from the analyzer over a Wide Area Network, to analyze the service request, and to transmit the service request to the remotely located device over the Wide Area Network.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '216 patent discloses everything in Claim 1 with the exception of the service depot, and relies on the '911 patent to remedy that deficiency. Further, the Office Action takes Official Notice that communication over a Wide Area Network is "well known and expected in the art."<sup>1</sup>

The '216 patent is directed to a method and system for determining whether problems exist in a business office device by analyzing user settings of the business office device. However, as admitted in the Office Action, the '216 patent fails to disclose a service depot comprising a computer configured to receive a service request from an analyzer over a Wide Area Network, to analyze a service request, and to transmit the service request to the remotely located device over the Wide Area Network, as recited in Claim 1.

The '911 patent is directed to a method and apparatus for allocating a plurality of resources to a plurality of jobs by using a computer. As shown in Figure 1, the '911 patent discloses a computer X for allocating resources to jobs and configured to communicate with three hand-held terminals H1, H2, H3 used by technicians T1, T2, and T3, respectively. The '911 patent discloses that, based on a time at which each resource or technician is forecast to become available and the time required for each job to be assigned, the system allocates the technicians to the jobs. Regarding the receiving of a security request from an analyzer over a

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<sup>1</sup> See page 3 of the Office Action dated April 16, 2004.

Wide Area Network, the Office Action asserts that the '911 patent discloses that "the computer X can also review alarms from a fault monitoring system associated with the telecommunications network."<sup>2</sup> However, Applicants respectfully submit that the '911 patent fails to disclose a service depot configured to receive a service request from an analyzer of a Wide Area Network, wherein the service request is to be performed on the remotely located device, as recited in Claim 1. Rather, the alarms from the fault monitoring system disclosed by the '911 patent, relate to faults in the network itself. Moreover, Applicants respectfully submit that the '911 patent fails to disclose a service depot configured to transmit the service request to a remotely located device over the network. Rather, although the alarms disclosed by the '911 patent may become jobs to be performed by the technicians, service requests to be performed on the device are not sent to the device based on received status information from the device, as recited in Claim 1. The alarms/jobs disclosed by the '911 patent are not based on the state or events of the hand-held terminals H1-H3.

Thus, no matter how the teachings of the '216 and '911 patents are combined, the combination does not teach or suggest a service depot configured to receive a service request to be performed on a remotely located device from an analyzer over a Wide Area Network, and to transmit the service request to the remotely located device over the Wide Area Network, as recited in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection of Claim 1 (and dependent Claims 3 and 6-8) should be withdrawn.

Claims 11 and 21 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the

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<sup>2</sup> '911 patent, column 6, lines 12-14.

rejection of Claim 11 (and dependent Claims 13 and 16-18) and Claim 21 (and dependent Claims 23 and 26-28) should be withdrawn.

Regarding the rejection of dependent Claims 4, 9, 10, 14, 19, 20, 24, 29, and 30 under 35 U.S.C. § 103, Applicants respectfully submit that the '783 and '358 patents fail to remedy the deficiencies of the '216 and '911 patents, as discussed above. Accordingly, for the reasons stated above for the patentability of independent Claims 1, 11, and 21, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of dependent Claims 4, 9, 10, 14, 19, 20, 24, 29, and 30 should be withdrawn.

The present amendment also sets forth new Claims 31-33 for examination on the merits. Claim 31, which depends from Claim 1, recites that the service depot is configured to transmit the service request to an owner of the remotely located device as an electronic mail message. Claim 31 is supported by the originally filed specification and does not add new matter.<sup>3</sup> Claims 32 and 33 recite limitations analogous to the limitations recited in Claim 31.

Thus, it is respectfully submitted that independent Claims 1, 11, and 21 (and all associated dependent claims) patentably define over any proper combination of the '216, '911, '783, and '358 patents.

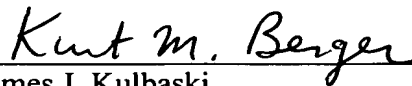
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<sup>3</sup> See paragraph 28 of the specification.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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<b>Interview Summary</b>	Application No. 09/575,710	Applicant(s) MOTOYAMA ET AL.	
	Examiner Quang N. Nguyen	Art Unit 2141	

All participants (applicant, applicant's representative, PTO personnel):

(1) Quang N. Nguyen. (3) \_\_\_\_\_.

(2) Mr. Kurt Berger. (4) \_\_\_\_\_.

Date of Interview: 13 July 2004.

Type: a) ☐ Telephonic b) ☐ Video Conference  
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1.

Identification of prior art discussed: Motoyama and Walker.


Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The examiner and the applicant's representative discussed about the cited prior arts (Motoyama and Walker) which are used to apply to the rejection of claim 1. The examiner agreed to consider the applicant's argument and will review it in details when the applicant sends in the request for reconsideration.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

 7/13/04  
 Examiner's signature, if required